IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of Yousheng Shen, et al.

Application No. 10/621,637

Filed: July 17, 2003

For: U.S. Patent No. 5,650,054

MERGED PROCEEDINGS FOR REEXAMINATION AND REISSUE APPLICATIONS

In re Yousheng Shen, et al.

Reexamination Proceeding

Control No. 90/006,209

Filed: January 29, 2002

For: U.S. Patent No. 5,650,054

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P.O. Box. 1450
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

This paper is filed in response to the Final Office Action mailed on December 30, 2009 ("December 2009 FOA"), in the above-captioned Merged Proceeding and accompanies a Notice of Appeal.

Applicants' Request on Pre-Appeal:

Applicants respectfully request that the claim rejections be reversed and that the Examiner be directed to fully and substantively examine the patentability of all claims pending in the above-referenced Merged Proceeding, including the reexamination claims, the reissue claims, and those claims newly introduced in this Merged Proceeding. Applicants respectfully request that the Examiner be prohibited from a misplaced reliance on the doctrine of *res judicata*.

Brief Procedural Posture of Merged Proceeding:

Claims 1 – 67, 70 – 74, 76 – 132 are pending in the Merged Proceeding.

Claims 1 – 5, 9 – 13, 29 - 34, 52 – 57, 61 – 67 and 70 – 74, 76 – 82, 86 – 90, 106 – 117 and 121 – 132 stand rejected and are the subject of this Pre-Appeal Brief Request.

Claims 1 – 64 from US 5,650,054 to Shen et al. were the subject of a Reexamination (No. 90/006,209) that went up to appeal. In a Decision mailed March 28, 2007, the Board affirmed the Examiner's rejection of claims 1, 2, 9 – 12, 29 – 34, 52, 54, 61 – 67 and 68 - 69, reversed the Examiner's rejection of claims 3 – 5, 55 – 57 and 68 – 69, and entered new grounds of rejections for claims 5, 13 and 57. Applicants then reopened prosecution in the Reexamination application. The Office subsequently opted to merge the reopened Reexamination with a co-pending Reissue of US 5,650,054 (No. 10/621,637). The Reissue application contained original versions of certain of the reexamination claims and additional new claims. The Merged Proceeding includes claims 1 – 67 and 70 – 127 corresponding to the then-pending reissue and reexamination claims. During the prosecution of this Merged Proceeding, new claims 128 – 132 were added, claim 75 was cancelled, and claims 66, 67, 73, 76 – 78, 112, 126 and 128 have been amended.

Statement of Factual and Legal Errors:

The rejections of the claims are based, at least in part, on the following clear factual and legal errors:

1) The Examiner improperly rejects claims 1, 2, 9 – 12, 29 – 34, 52, 54 and 61 – 64 on the ground of *res judicata*.
   - Applicants respectfully submit that the doctrine of *res judicata* is not applicable when a new record is presented to the Office during the course of patent prosecution. In Applicants' September 2009 Response, pages 33-39, Applicants fully discussed the inapplicability of *res judicata* in the present case.
   - A new record is before the Office. (See September 2009 Response.) Applicants have presented new arguments as to the patentability of the claims and new evidence (e.g., Surampudi, Nafion Data Sheet, Onishi, etc.) in support of these arguments.
     - For example, Applicants have presented a new record as to the individual and combined teachings of Dempsey, Uchida, Vanderborgh, and Grot, and as to why

persons of ordinary skill in the art would not and could not successfully combine Uchida, Grot and/or Vanderborgh with Dempsey. (See September 2009 Response, pages 41-51.) In fact, Applicants have provided reasoned arguments as to why Dempsey would be rendered inoperable and/or unsatisfactory for its intended purposes should its electrodes be replaced with any of the electrodes of Uchida, Grot and/or Vanderborgh.

- The Examiner relies on *res judicata* to avoid consideration of the inoperability of Dempsey as modified by Uchida, Grot and/or Vanderborgh, stating simply that "the claims are still rejected under the same references as were utilized in [the] previous appeal." (December 2009 FOA, pages 16-17.)
- Applicants submit that the reason that the claims are *nominally* still rejected under the same references is that the Examiner invokes *res judicata* and thereby refuses to fully and substantively address Applicants' new arguments and new evidence. (December 2009 FOA, page 17, item 47.)
- Applicants respectfully request that this catch-22 – wherein *res judicata* is applied because the claims are rejected, and therefore, because *res judicata* is applied, the Examiner need not fully and substantively examine the rejected claims – be ended and that the Examiner be directed to substantively address Applicants' new arguments.

2) The Examiner improperly refuses to fully and substantively examine claims 3 – 5, 13, 55 – 57, 65 – 67 and 70 – 74, 76 – 82, 86 – 90, 106 – 117 and 121 – 132, which include Reexamination claims (including claims whose rejections were reversed on Appeal and claims whose prosecution was reopened), Reissue claims, and new Merged Proceeding claims, based on a mistaken reliance on the Board's findings in the Reexamination Decision.
   - For example, the Examiner refuses to fully and substantively address Applicants' new arguments and new evidence presented with respect to, at least, the following issues:
     - the teachings of Uchida (US 5,474,857);
     - the teachings of Dempsey (US 4,277,984);
     - combining Dempsey with Uchida;
     - combining Dempsey with Grot (US 5,330,860); and

- combining Dempsey with LaConti (US 4,820,386).

- For each of the above issues, the Examiner relies, at least in part, on the Board's findings in the Reexamination Decision. The Examiner asserts:

> With respect to the various arguments concerning the continued rejection of the combination of Dempsey in view of Uchida, Grot, and/or Vanderborgh, the examiner is utilizing these references in the same manner as they were in the examiner's answer of 7/17/2003 in the reexam 90/006,209. The examiner was completely affirmed on issues related to this combination in the decision of 3/28/2007, and it is unclear of the relevance of applicant's continued traversal of the combination of Dempsey with any of Uchida, Vanderborgh, or Grot. The claims are rejected under *res judicata* and it does not appear that further arguments against a combination meet the threshold of new evidence as defined by *In re Herr* and *In re Russell*. (December 2009 FOA, page 17 and February 2009 OA, page 18.)

- Although, in certain instances, "for the sake the completeness," the Examiner has then proceeded to substantively address selected portions of Applicants' new arguments and new evidence with respect to these issues, the Examiner has never fully substantively addressed the issues.

  - As one representative example, with respect to the teachings of Uchida, Applicants have shown that Uchida fails to disclose the claimed composition of the "electrical conducting material of the sensing and counter electrodes." (See September 2009 Response, pages 45-46 and December 2008 Response, pages 47-48.) The Examiner has failed to comment on this reasoned and supported new argument (as if the argument was never presented), and instead, has repeatedly merely cited to the *Reexamination Request* for evidence that Uchida satisfies the claimed percentages. (See December 2009 FOA, pages 4-5; April 2009 OA, page 7; February 2009 FOA, pages 6-7; May 2008 OA, page 7.)

3) The Examiner has himself introduced new evidence (i.e., evidence not before the Reexamination Board) and has entered new rejections based, at least in part, on this new evidence. Yet, the Examiner improperly refuses to fully and substantively address Applicants' arguments regarding this new evidence and these new rejections.

- As one example, the very first time that the Examiner applied Vanderborgh (US 4,804,592) to reject claims (in combination with Dempsey) was in the Merged Proceeding (see May 2008 OA). The Examiner has repeatedly asserted that Vanderborgh discloses the claimed composition of the electrodes (see, December 2009 FOA, page 5; April 2009 OA, page 8; February 2009 FOA, page 7; and May 2008 OA page 7), but has never addressed Applicants' substantive arguments to the contrary. (See September 2009 Response, page 47 and December 2008 Response, pages 48-49.) Applicants submit that Vanderborgh is new evidence. Applicants further submit that the record with respect to Vanderborgh has not been fully developed.

Conclusion

Applicants submit that a new record, including new arguments, new evidence and new claims, has been developed over the course of the instant prosecution.

Applicants respectfully submit that the Examiner's invocation of *res judicata* and his summary application of the Board's findings in the earlier Reexamination proceeding are improper in view of this new record before the Office and the Office's mandate to grant patents on inventions that comply with the patent statute.

Applicants respectfully request that the Examiner fully and substantively consider the new record, at the very least, so that all issues of patentability may be fully developed should the matter go to appeal.

Respectfully submitted,
Shen et al.

Date: March 30, 2010

By: _____
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